

Application No.: 09/640,002

Docket No.: 21994-00011-US

REMARKS

The Office Action and prior art relied upon have been carefully considered. In an effort to expedite the prosecution claims 1 and 2 have been amended to clarify the patentable aspects of the invention.

Claims 1 and 2 were previously rejected under 35 U.S.C. § 102(a) as fully anticipated by applicant's admitted prior art as discussed on pages 1 and 2 of the specification and shown in Fig. 10.

The present invention is provided with a switch 114 (Figs. 1-3) that is either pressed halfway down or all the way down. Controlling means 112, 212 and 312 of various embodiments change the size of a picture of either or both of a moving picture and a still picture when the switch 114 is pressed halfway down. For example see page 8, lines 10-27 of the specification.

The control means also causes display of both the moving picture and the still picture in a viewfinder 8 (display means), simultaneously. See page 9, lines 5-10

The control means also controls a field memory 104 (recording means) to record a digital video signal of the still picture information on a recording medium 7 when the switch 114 is pressed down fully. See page 9, lines 11-18 of the specification.

The acknowledged prior art is constructed to operate quite differently. Switch 5 shown in Fig. 10 (prior art) outputs either moving picture information or still picture information simultaneously to the VTR (recording medium) 6, the recording medium 7 and the viewfinder (display means) 8 all in parallel. Thus, the prior art switch 5 is completely different from the switch 114 of the present invention, which causes the recorder to operate differently when pressed halfway down as compared to being pressed down fully.

Further, the prior art fails to teach control means for controlling recording in accordance with the extent of depressing switch 114.

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As mentioned on page 2, line 27-page 3, line 3, the prior art recorder cannot record moving picture information while recording still picture information. This is a problem solved by the present invention as discussed on page 3 lines 6-20 of the specification.

For these reasons the prior art is believed to be completely different from the present invention.

Anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims. *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986). There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102. *Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991); *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (Fed. Cir. 1984).

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21994-00011-US from which the undersigned is authorized to draw.

Dated: September 8, 2004

Respectfully submitted,

By _____

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